REMARKS

I. Status of the Claims

Claims 1, 4, 5, 8-20 and 22-29 are pending. Claims 15-17 and 29 are withdrawn. With this amendment, claims 1 and 5 are amended, claim 4 is canceled and new claims 30-31 are added.

II. Amendments to the Specification

Paragraph [0029] on page 9 of the specification as originally filed is amended to delete reference to "prevention" as indicated herein. No new matter is added by way of this amendment.

III. Amendments to the Claims

Claim 1 is amended to incorporate the limitations of claim 4. Specifically, claim 1 as amended recites "wherein at least 75 wt. % of the active agent in the dosage form is released within the time period."

Claim 1 is further amended to delete the phrase, "following said administering to a patient in the fed mode, the dosage form is retained in the upper gastrointestinal tract for a time period of about 4 to 9 hours."

Claim 5 is amended to depend on claim 1.

New claims 30-31, directed to administering a dosage form which is retained in the upper gastrointestinal tract for a specified time period, find support in original claims 2 and 3. New claims 30-31 depend on amended claim 1.

Accordingly, the claim amendments do not introduce new matter.

IV. Rejection Under 35 U.S.C. § 112

The Examiner rejected claims 18-20 under 35 U.S.C. § 112, first paragraph for lack of enablement. Specifically, the Examiner stated that while the specification is enabling for "treating a human patient suffering from a bacterial infection," the specification does not reasonably provide enablement for "preventing or curing a human patient suffering from a bacterial infection." The Examiner then further states that claims 18-20 are drawn to a method of treating a human patient suffering from a bacterial infection and notes that the

term "treatment" and "treat" are defined in the specification as including prevention of the occurrence of symptoms and/or their underlying cause.

Without acquiescing, Applicants have amended paragraph [0029] on page 9 of the specification to delete reference to "prevention of the occurrence of symptoms and/or their underlying cause," and "prevention" of a particular disorder.

Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 112.

V. Allowable Subject Matter

In the Office Action dated January 20, 2010, the Examiner indicated that claims 4-5, 8-10, and 22-28 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 1 is amended to recite the limitations of claim 4. Claim 4 is presently canceled. Claims 5, 8-10 and 22-28 either directly or indirectly depend on amended claim 1.

Applicants have presently deleted from claim 1 recitation of the limitation, "the dosage form is retained in the upper gastrointestinal tract for a time period of about 4 to 9 hours." Applicants remind the Examiner that this limitation was added to claim 1 in the response filed September 26, 2009, after the Examiner indicated that claim 3, which recited "the dosage form is retained in the upper gastrointestinal tract for a time period of about 4 to 9 hours," would be allowable if rewritten in independent form including all limitations of the base claim and any intervening claims (see page 5 of the Office Action dated July 7, 2009). However, the Examiner subsequently stated in an Examiner-initiated interview on December 31, 2009, that the addition of this limitation to claim 1 would not overcome the double-patenting rejection (see the Examiner-Initiated Interview Summary document for the interview of December 31, 2009, mailed on January 20, 2010).

Accordingly, Applicants understand that claim 1 as presently amended to recite the limitations of claim 4, will be deemed allowable by the Examiner.

Applicants further note that claims 11-14 depend directly or indirectly from amended claim 1, which the Examiner indicated would be allowable. Because claim 1 as presently amended includes all of the limitations of claim 4, any claims dependent on amended claim 1 should also be deemed allowable. Applicants respectfully request indication of same.

VI. Double-Patenting Rejection

Claims 1, and 11-14 were rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 19, 20 and 40 of U.S. Patent No. 6,340,475.

Claim 1 is amended to incorporate the limitations of claim 4. Claims 11-14 depend directly or indirectly from claim 1. As stated above, because amended claim 1 now recites subject matter deemed by the Examiner to be allowable, claims 1 and 11-14 should be found allowable.

Applicants respectfully request withdrawal of the double-patenting rejection.

VII. Conclusion

For the reasons above, Applicants respectfully submit that the pending claims are novel and non-obvious over the cited art. Furthermore, Applicants respectfully submit that all criteria for patentability have been satisfied and the pending claims are in full condition for allowance. A Notice of Allowance is therefore respectfully requested.

If the Examiner has any questions or believes a telephone conference would expedite the prosecution of this application, Applicants request that the Examiner call the undersigned at (650) 590-1919.

No fees are believed due with this communication. However, the Commissioner is hereby authorized and requested to charge any deficiency in fees herein to Deposit Account No.:50-4616.

Respectfully submitted,

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